APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,758	12/08/2000	Stefano Faccin	59864.00529	9624

32294	7590	07/12/2006	

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EXAMINER
CHANKONG, DOHM

ART UNIT	PAPER NUMBER
2152	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/731,758	FACCIN ET AL.
	Examiner	Art Unit	
	Dohm Chankong	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 April 2006*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-84* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-84* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1>   This action is in response to Applicant's amendment and remarks, filed 4.14.2006.

Claims 1-84 are submitted for further examination.

2>   Because of the new grounds of rejection in this action, this is a non-final rejection.

Allowable Subject Matter

3>   The indicated allowability of claims 32 and 33 is withdrawn in view of the newly

discovered reference(s). Rejections based on the newly cited reference(s) follow.

Response to Arguments

I.   <u>Claims 1-31 and 34-84 rejected as being unpatentable over Pepe, in view of Cook</u>

    Applicant's arguments have been carefully considered but are not persuasive.

Applicant first argues that Pepe does not teach providing an identification of a subscriber and

an access to a visited network from a home network. <u>Applicant's remarks</u>, pg. 30, ¶3.

Applicant erroneously asserts that independent claims 1, 34 and 78 contain this feature. The

amended independent claims clearly state that an identification of the subscriber be sent

<u>from</u> the visited <u>to</u> the home network. Pepe clearly discloses this functionality.

    Pepe is generally directed towards a messaging network. Pepe describes a well known

feature known as automatic roamer registration whereby visiting networks receiving

subscriber profiles from home networks in order to determine types of accesses available to a

subscriber [column 2 «lines 13-37»]. Pepe discloses a database that stores subscriber profiles,

the profiles containing information regarding the type of accesses available to the subscriber [column 6 «lines 11-18 and 47-52»]. When accessing a visited network, a subscriber sends his user identification and access request (service request) to the database, which supports subscriber authentication [column 6 «lines 47-59»].

Coupled with Pepe's teaching of the automatic roamer registration feature, it would have been obvious to one of ordinary skill in the art that Pepe discloses the claimed feature of sending an identification of the subscriber and access from a visiting network to the home network in order to retrieve the subscriber's profile. As taught by Pepe, the profile is provided from the subscriber's home network (the database) to the visited network [column 2 «lines 13-37»].

Applicant next argues that Pepe does not teach the feature of comparing the access to be provided to the subscriber and the stored subscriber profile. Applicant's remarks, pg. 32, ¶1. Contrary to Applicant's argument, this feature is implicit in Pepe's teachings. Pepe discloses expressly that the subscriber profile contains the services to which the subscriber may access [column 6 «lines 11-13»]. Pepe also discloses that the profile is used to validate the services. The comparison feature is implicit within this validation process whereby Pepe's system determines whether the current access request to a service is allowed by comparing the request to the services in the subscriber's profile.

Claims 37 and 68 have been amended to state providing an identification to the visited network from the home network. However, as discussed further below, this amendment suffers from new matter issues. Additionally, Pepe still discloses this amended feature

because the subscriber profile provided from the home network database can be reasonably

interpreted as an identification of the subscriber and access to be provided to the subscriber.

II.   Claims 1, 34, 37, 68 and 78 rejected as being unpatentable over Lahtinen et al

Applicant's arguments have been carefully considered but are not persuasive.

Applicant again erroneously asserts that the independent claims contain the feature of

providing an identification of a subscriber and an access to a visited network from a home

network. Applicant's remarks, pg. 28, ¶3. Claims 1, 34 and 78 clearly state sending, from a

visited network, an identification of the subscriber and an access to be provided. Lahtinen

discloses the features of claim 1.

Applicant first argues that Lahtinen does not teach providing an identification of the

subscriber and an access to be provided. This argument ignores common knowledge available

to one of ordinary skill in the art. Lahtinen discloses that after a user registers in a visited

network, the user's information is transferred to the visited network from the home network

[column 3 «lines 8-26»]. Lahtinen does not expressly state that the user's identity or access

request are sent from the visiting network. But such a step is implicit because the user's

information is retrieved from the home network. If the user's identity is not sent from the

visited network, then it would be impossible to retrieve the correct information. Thus, the

step of providing the user's identification is implicit in Lahtinen's system.

Next Applicant argues that Lahtinen does not teach controlling access based on a

comparison of the access to be provided and the stored subscriber profile. Applicant's

remarks, pg. 29, ¶1. However, Lahtinen clearly teaches that the user's profile contains

authorization information concerning whether the user can access a service [column 7 «lines 30-34»]. It would be clear to one of ordinary skill in the art that the user's profile is necessary to validate a user's access request by comparing the request with the services that the user is authorized to access.

III.   Claims 1, 34, 37, 68 and 78 rejected as being unpatentable over Hoffman

Applicant's arguments have been carefully considered but are not persuasive. Applicant erroneously asserts that the independent claims contain the feature of providing an identification of the subscriber and an access to be provided to the subscriber to the visiting network from the home network. Applicant's remarks, pg. 27, ¶1. Claims 1, 34 and 78 state that an identification is sent, from the visited network, to the home network. Hoffman disclose the claimed limitations.

Hoffman discloses sending, from a visited network, an identification of the subscriber and an access to be provided to the subscriber, to a home network [column 1 «lines 31-47» | column 3 «lines 60-64»]. Again, while not expressly disclosed, the feature of providing the subscriber's identification and access request are implicit. The provision of these elements, and especially the subscriber's identification, is necessary to retrieve the subscriber's profile from the home network.

Hoffman additionally discloses that the profile contains access privileges [column 3 «lines 60-64»]. It is well known to one of ordinary skill in the art the functionality of access privileges. A comparison is necessary to determine whether a user may access certain

services whereby the user's request is compared with the access privileges stored in the

profile. This is an obvious feature and is implicit in Hoffman's system.

IV.   Conclusion

Applicant's arguments have been carefully considered but are not considered

persuasive. The 102(e) Cook rejection is withdrawn. The other claim rejections set forth in

previous Office action are maintained.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent
possible harassment by multiple assignees. A nonstatutory obviousness-type double
patenting rejection is appropriate where the conflicting claims are not identical, but at least
one examined application claim is not patentably distinct from the reference claim(s) because
the examined application claim is either anticipated by, or would have been obvious over, the
reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re
Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ
645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*,
422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644
(CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may
be used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent either is shown to be
commonly owned with this application, or claims an invention made as a result of activities
undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR
3.73(b).

4>   Claims 1-84 rejected on the ground of nonstatutory obviousness-type double patenting

as being unpatentable over claims 1-38 of U.S. Patent No. 6.725.036. Although the conflicting

claims are not identical, they are not patentably distinct from each other. Claim 1 is taken as

an example from the instant application and the conflicting patent:

Instant Application : Claim 1	U.S Patent No. 6.725.036 : Claim 1
1. A method of controlling access of a subscriber to a network comprising:	1. A method of controlling an application level of access to any of a plurality of networks comprising:
sending, from a visiting network of a plurality of networks connected to a home network, an identification of the subscriber and an access to be provided to the subscriber	sending an identification of the subscriber and an application level of access to be provided to the subscriber from a visited network which is one of the plurality of networks and is connected to a home network
in response to the identification of the subscriber and access to be provided to the subscriber, storing, in the visited network, a subscriber profiled of an authorized access of a plurality of authorized accesses to be provided to the subscriber; and	in response to the identification of the subscriber and the application level of access to be provided to the subscriber in any of the plurality of networks or the home network, storing a subscriber profile of an authorized application level of access to be provided to the subscriber in any of the plurality of networks or the home network; and
controlling access of the subscriber to a network dependent upon a comparison of the access to be provided to the subscriber and the stored subscriber profile having the authorized access of the plurality of authorized accesses.	controlling access of the subscriber to any of the plurality of networks or the home network through subscriber equipment and the visited network dependent upon a comparison of a request for an application level of service to be provided to the subscriber in the plurality of networks or the home network and the stored subscriber profile.

Claim 1 of the patent reference providing an application level of access while claim 1 of the

instant application provides access. The difference between the claims would be obvious to

one of ordinary skill in the art.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5>   Claims 37 and 68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the written description requirement. The claim(s) contains subject matter which was

not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention.

        a.   Claims 37 and 68 have been amended to disclose a feature whereby a subscriber

identification is provided to the visited network. Applicant's specification discloses

providing subscriber identification from the visited network, to the home network

[see for example, Applicant's abstract, Figure 7].

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6>   Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

        b.   Claim 1 states: "sending, from a visited network of a plurality of networks

connected to a home network, an identification of the subscriber...". However, the

claim does not state to what element that the identification and the access to be

provided are sent, merely that it is sent from a visited network.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to a
> person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

7>   The text of those sections of Title 35, U.S. Code not included in this action can be

found in a prior Office action.

8>   Claims 1-31 and 34-84 rejected under 35 U.S.C 103(a) as being unpatentable over Pepe

et al, U.S Patent No. 5,742,668 ["Pepe"].

9>   As to claim 1, Pepe discloses a method of controlling access of a subscriber to a

network comprising:

sending, from a visiting network of a plurality of networks connected to a home

network, an identification of the subscriber and an access to be provided to the subscriber

[column 2 «lines 19-37» | column 6 «lines 47-52»: provision of identification is implicit in

order to retrieve the correct profile from home network];

in response to the identification of the subscriber and access to be provided to the subscriber, storing, in the visited network, a subscriber profiled of an authorized access of a plurality of authorized accesses to be provided to the subscriber [column 2 «lines 19-37»]; and

controlling access of the subscriber to a network dependent upon a comparison of the access to be provided to the subscriber and the stored subscriber profile having the authorized access of the plurality of authorized accesses [column 2 «lines 19-37» | column 6 «lines 11-27» and 47-52»].

10>   As to claims 34, 37, 68 and 78, see rejection of claim 1.

11>   Claims 32 and 33 are rejected under 35 U.S.C § 103(a) as being unpatentable over Pepe, in view of Hoffman, U.S Patent No. 6.148.199.

12>   As to claims 32 and 33, Pepe does not disclose the claimed features. However, in the same field of invention, Hoffman discloses:

an application level registration message containing the identification of the subscriber and the access is generated in response to a request from subscriber equipment to a visited network entity [column 1 «lines 31-37»];

in response to an entity in the visited network receiving the request, an address of an entity in the home network is obtained from a routing analysis in the visited network [column 1 «lines 37-41»];

the application level registration message is transmitted to the address in the home

network [column 1 «lines 37-41»]; and

an entity of the home network obtains the subscriber profile in response to receipt of

the application level registration message [column 1 «lines 31-41»].

It would have been obvious to one of ordinary skill in the art to incorporate

Hoffman's well known teachings into Pepe's system. One would have been motivated to

provide such a combination because such functionality is well known in the art for providing

subscriber profiles to visited networks from home networks.

13>   Claims 1, 34, 37, 68 and 78 rejected under 35 U.S.C §103(a) as being unpatentable over

Lahtinen et al, U.S Patent No. 6.745.029 ["Lahtinen"].

14>   As to claim 1, Lahtinen discloses a method of controlling access of a subscriber to a

network comprising:

sending, from a visiting network of a plurality of networks connected to a home

network, an identification of the subscriber and an access to be provided to the subscriber

[column 3 «lines 8-26» : provisioning of subscriber identification is implicit in order to

correctly transfer the user's information];

in response to the identification of the subscriber and access to be provided to the

subscriber, storing, in the visited network, a subscriber profiled of an authorized access of a

plurality of authorized accesses to be provided to the subscriber [column 3 «lines 20-34»]; and

controlling access of the subscriber to a network dependent upon a comparison of the

access to be provided to the subscriber and the stored subscriber profile having the authorized

access of the plurality of authorized accesses [column 7 «lines 44-50» : profile information

contains whether a user is authorized to user services. Comparison feature is implicit.].

15>   As to claims 34, 37, 68 and 78, see rejection of claim 1.

16>   Claims 1, 34, 37, 68 and 78 rejected under 35 U.S.C §103(a) as being unpatentable over

Hoffman.

17>   As to claim 1, Hoffman discloses a method of controlling access of a subscriber to a

network comprising:

sending, from a visiting network of a plurality of networks connected to a home

network, an identification of the subscriber and an access to be provided to the subscriber

[column 1 «lines 31-47»];

in response to the identification of the subscriber and access to be provided to the

subscriber, storing, in the visited network, a subscriber profiled of an authorized access of a

plurality of authorized accesses to be provided to the subscriber [column 1 «lines 31-47»]; and

controlling access of the subscriber to a network dependent upon a comparison of the

access to be provided to the subscriber and the stored subscriber profile having the authorized

access of the plurality of authorized accesses [column 1 «lines 31-47» | column 3 «lines 60-64»

: comparison feature is implicit based on Hoffman's teaching of access privileges for the

subscriber].

18>   As to claims 34, 37, 68 and 78, see rejection of claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942.

The examiner can normally be reached on Monday-Thursday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

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9197 (toll-free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-9199 (IN USA

OR CANADA) or 571-272-1000.

DC

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SUPERVISORY PATENT EXAMINER